



AP.PRE.REQ

PTO/SB/33 (07-05)

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## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

ALPINE.036A45

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on

07/23/07

Signature

Yasuo Muramatsu

Typed or printed name

Yasuo Muramatsu

Application Number

10/686,895

Filed

10/16/2003

First Named Inventor

Hirofumi Onishi

Art Unit

3663

Examiner

Ronnie Mancho

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number

38,684

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attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

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Date

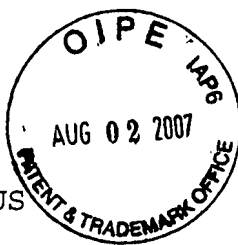
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

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\*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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ALPINE.036AUS

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

|            |   |                          |   |                     |
|------------|---|--------------------------|---|---------------------|
| Applicant  | : | Hirofumi Onishi          | ) | Group Art Unit 3663 |
|            |   |                          | ) |                     |
| Serial No. | : | 10/686,895               | ) |                     |
|            |   |                          | ) |                     |
| Filed      | : | October 16, 2003         | ) |                     |
|            |   |                          | ) |                     |
| For        | : | DISPLAY METHOD AND       | ) |                     |
|            |   | APPARATUS FOR NAVIGATION | ) |                     |
|            |   | SYSTEM                   | ) |                     |
|            |   |                          | ) |                     |
| Examiner   | : | Ronnie M. Mancho         | ) |                     |
|            |   |                          | ) |                     |

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ARGUMENTS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Hon. Commissioner  
of Patents and Trademarks  
Alexandria, VA 22313-1450

Dear Sir:

In response to the final office action dated March 22, 2007, the applicant requests review of the legal and factual basis of the final rejection in the above-identified patent application. This review being requested because of clear errors in the examiner's rejections and the examiner's omission of essential elements need for a prima facie rejection. This request is accompanied by a Notice of Appeal submitted concurrently herewith.

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REMARKS

Claims 1-18 are pending where Claims 1, 7 and 13 are independent, where the most recent listing of claims is provided in the applicant's response dated November 29, 2006. In the final office action, the examiner rejected all of the claims on the basis of substantially the identical rejections as in the previous office actions dated May 5, 2005, November 14, 2005, and June 29, 2006. Namely, in the final office action, the examiner rejected Claims 1-18 under 35 U.S.C. 112, second paragraph, as being infinite and also under 35 U.S.C. 102(b) as being anticipated by Miyaki (U.S. Patent Application Publication No. 2002/0130906) by repeating the same reasoning as in the prior office actions.

As stated in the specification, the gist of the present invention is to allow the user to easily know whether a specified point of interest (POI) such as a drug store resides within a large structure such as a hospital building by attaching an icon such as hospital icon next to the name of the drug store in the POI list shown on the navigation screen. An example of large structure includes a shopping mall, airport, sports stadium, train station, office building, etc. Suppose a user is going to see a medical doctor on a particular day, but he/she wants to do several errands as well such as buying medicine and flower on the same day, the present invention enables the user to easily know whether there are a drug store and/or a florist in the hospital. Other situations

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where the present invention can be conveniently applicable are described at page 4, lines 13-28 in the specification.

In the office action of June 29, 2006 and the current office action of March 22, 2007, the examiner rejected Claims 1-18 under 35 U.S.C. 112, second paragraph, as being indefinite, on the ground that the terms "large" and "type" are not clear. The applicant has explained in the response of November 29, 2006 why these terms do not render the claims indefinite stating that acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed in light of the specification and that the fact that claim language includes relative terms does not automatically render the claim indefinite. MPEP 2173.05(b).

The applicant has also explained that in this particular invention, the term "large structure" even helps to understand the invention because the point of the invention is directed to the situation where specified POIs such as restaurants, shops, etc. are located within a large structure such as a shopping mall. Because of the unique nature of the invention, the term "large structure" provides the reader better understanding of the invention. The term "type" also helps to clarify the invention because the icon used in the present invention is to show the type, i.e., category, of the large structure rather than its name.

Notwithstanding this clarification, in the final office action dated March 22, 2007, at page 9, lines 1-5, the examiner ignores the applicant's arguments and repeats the same insufficient

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reasoning that the term "large" is relative term and the term "type" is unnecessary. The examiner did not consider the specific character of the present invention and did not provide any basis of rejection in light of the invention. Since the examiner has ignored or failed to properly consider this issue, there is a clear error in the examiner's rejection and the examiner's omission of essential elements needed for a prima facie rejection.

Further, as clearly stated in Claims 1, 7 and 13, the navigation system of the present invention displays a list of names of POI specified by the user, and if the specified POI is located within a large structure, the list shows the icon representing the type of the large structure next to the name of the specified POI. Throughout the prior and current office actions, the examiner has indicated that this feature is disclosed by the cited Miyaki reference without showing any specific basis. In reality, the cited Miyaki reference is not related to any situation where POIs are included within a large structure.

For example, with respect to the limitation "if the specified POI is located within a large structure", the examiner did not show in any of the office actions as to which element of Miyaki corresponds to the specified POI and which element of Miyaki corresponds to the large structure. Further, with respect to the limitation "the list includes the icon representing the type of the large structure next to the name of the specified POI", the examiner did not show in any of the office actions as to which

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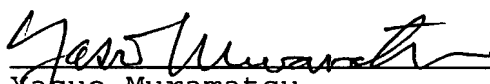
element of Miyaki corresponds to the name of the specified POI and which element of Miyaki corresponds to the icon of the large structure, let alone displayed next to one another. In all of the previous responses, the applicant has explained in detail that the cited Miyaki fails to show the essential elements of the present invention noted above. Since the examiner has ignored or failed to properly consider these essential elements, there is a clear error in the examiner's rejection and the examiner's omission of essential elements needed for a prima facie rejection.

In view of the arguments presented in the responses dated August 5, 2005, January 16, 2006, November 29, 2006 and the supplemental arguments presented herein, the applicant submits that the final office action dated March 22, 2007 fails to set forth prima facie rejections for the claims of the present invention. Accordingly, the applicant respectfully request a finding that the application is allowed on the existing claims.

Respectfully submitted,

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Dated: 7/23/2007

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